

In re Appln. of LAWTON et al.  
Serial No. 09/260,837

(1998)(hereinafter "W3C") in view of *Awareness Through Fisheye Views in Relaxed-WYSIWIS Groupware*, (1996)(hereinafter "GroupLab"). Claims 6, 15-17, 19-21, 24-26, and 28-29 have been rejected as obvious over W3C, further in view of GroupLab, further in view of *Edupage Newsletter* (February 4, 1997)(hereinafter "Edupage"). Claims 27 and 30 have been rejected as obvious over W3C, further in view of GroupLab, further in view of Edupage, and further in view of "*HTML Tags at a Glance*" (hereinafter "*HTML Tags*"). Claims 4 and 5 have been rejected as obvious over W3C, further in view of GroupLab, further in view of *W3C's Scalable Vector Graphics Specification* (February 11, 1999)(hereinafter "*SVG*").

It can be seen that each claim continues to be rejected under §103 and not § 102. Accordingly, there is no disagreement as to the fact that the invention is not itself described in the prior art. Applicants argued in their prior response that the cited combinations of teachings selected from various references is not motivated by the art itself, but rather seems to either have no motivation or to be motivated by the applicants' own claims. Applicants have previously noted that the prior art is not even combinable to yield the invention of any claim since the combination would not teach the claimed invention. Applicants reserve the right to later amplify on that theme, but at this point will only address the lack of motivation to combine.

As previously noted, the law imposes strict and clear requirements governing the Office's combining of references to reject any claim. In particular, there are three important requirements for any obviousness rejection. First, there must be a suggestion or motivation originating *in the art* to modify or combine the references in the asserted manner. MPEP §2143. Secondly, there must be a reasonable expectation of success, again found in the art, with respect to the asserted combination, and thirdly the references as combined must teach each and every element of the targeted claim. *Id.* Applicants respectfully assert that there does not exist any motivation in the art to make the asserted combinations.

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In order to respond to the Office action, applicants will first summarize their prior arguments and the Office's response thereto, before responding to the Office's additional reasoning.

In brief overview, applicants previously argued the following points regarding the alleged motivation to combine:

(1) With respect to claim 1 (and claims 7-13, 14, 18, and 22-30), there is no reason found in the art to make the asserted combination of W3C and GroupLab. The given rationale that "it would have been obvious ... to combine W3C's DOM [document object model] with GroupLab's thumbnail registration with a document since mapping coordinates to a data structure and thumbnails provide a means to link to another document" is simply a statement that one of skill in the art *could* combine the known art to arrive at the invention. However, the relevant legal standard requires a demonstrated motivation, not simply a demonstrated ability. The "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01

In the present case, the Office is simply asserting that all the *pieces* of the invention were known and that one of skill in the art would thus have been able to combine them to make the invention. Moreover, since the Office action seems to be assert that GroupLab's fisheye view used something analogous to thumbnails to provide a function similar to that of the invention, what is the motivation for *modifying* the fisheye view system to match the claims. The Office has not mentioned that the Fisheye technology was somehow deficient or otherwise in need of modification from the perspective of one of skill in the art at that time. Moreover, the Office asserts that the combination is desirable "since mapping coordinates to a data structure and thumbnails provide a means to link to another document." But this

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implies that there was no linking in the fisheye technique, which would seem to contradict the Office's other characterizations of GroupLab.

Thus the Office has presented an alleged motivation to combine the references, however the alleged motivation is a conclusory statement of ability and not motivation, and is not consistent with the references or the Office's characterizations thereof.

(2) With respect to dependent claims 4-7, the Office justifies combining SVG with W3C and GroupLab to reject by stating that "Since XML is a structured document, it would have made sense to one of ordinary skill in the art at the time the invention was made to incorporate images and vector graphics in a system for registering a thumbnail with a document since the technology for including images and vector graphics in structured documents already existed." The action itself thus clearly demonstrates that the Office is citing not an actual motivation to combine, but simply an ability to combine – it "would have made sense" (i.e. the artisan could have done it) since the "technology" (i.e. the ability) existed.

(3) With respect to claim 6, the action justifies combining Edupage with W3C and GroupLab by simply stating: "It would have been obvious ...to incorporate the applet [for word at a time display] with the system described jointly by W3C and GroupLab since the system represents a document model consisting of text and other components registered with a thumbnail." Not only does this rationale bootstrap off the prior improper combination, but in addition the cited motivation to add Edupage is lacking in and of itself. It essentially says that since the applet works with text and the combination of W3C and GroupLab works with text, the former can be combined with the latter. But of course an allegation that art can be

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combined has no bearing on whether the artisan would have made the combination, for that requires not just evidence of ability, but also evidence of motivation.

(4) With respect to claims 8-13, the action justifies the combination of W3C and GroupLab by stating that "since DOM represents the hierarchy of XML data that are linked to a portion of a document from a document model (as taught by W3C) and it was well known ... to provide reduced images (thumbnails) from which a user could select coordinates linking to the larger document, it would have been obvious... to combine W3C's DOM hierarchy with GroupLab's thumbnail registration with a document since mapping coordinates to a data structure and thumbnails provide a means to link to another document. Both thumbnails and DOM provide users with the ability to communicate with another document." Clarification was previously requested in that, assuming for the sake of argument that the action is right in that the artisan *could* make the asserted combination, why *would* the artisan do so? If "both thumbnails and DOM provide users with the ability to communicate with another document," as alleged, and if GroupLab shows something "analogous to a thumbnail," as alleged, then why *would* the artisan modify either GroupLab or W3C in the asserted manner?

#### The Office's Response

In response to the foregoing, the Office does not discuss most of the arguments but does address the combination of W3C and GroupLabs as follows:

In this case, W3C disclosure teaches that XML applications provide for the ability to link to a portion of a document from a document model. See abstract. Furthermore, it was well known in the art at the time of the invention to provide reduced images (thumbnails) from which a user could select coordinates linking to the larger document, as taught in GroupLab's thumbnail registration with a document. Both thumbnails and DOM provide users with the ability to link to another document by providing a "mapping" to a data structure. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the features taught by GroupLab ...

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with W3C's teachings... since it provides the user with the ability to communicate with another document.

...[G]iven that these two features [(DOM and mapping thumbnail to document)] were well known in the art at the time as a means for linking to a document, it would have been obvious ... to combine the two references as the mapping of a DOM or structure of an XML document would be the next logical step in representing the structure of a document in a reduced image format since it already took into account the structure of a document.

There are a significant number of legal and factual shortcomings exposed by the Office's response as quoted above. The primary thrust of the Office's reasoning is that since GroupLab and DOM have something in common ("...a 'mapping' to a data structure..."), then they are combinable. Fortunately, that is not the test for combinability. The MPEP clearly sets forth an entirely different test, one that requires that an actual motivation or suggestion be found in the art.

The fact that the teachings of two references have a common element says nothing about a motivation to combine. If the "something in common" rule were to replace the actual test for combinability, we could combine a horse with a cave (both have mouths), or a clock with a mountain (both have faces), or a snake and a condenser (both have coils). Silly examples aside, the "something in common" rule does not meet the standards set forth by the MPEP, and the simple existence of common elements clearly does not amount to a motivation to one of skill in the art to combine the teachings in questions.

Moreover, the asserted similarity among the references in the stated regard actually contradicts the alleged motivation to combine the references. The action states that one would be motivated to combine the references since "it provides the user with the ability to communicate with another document." However, the action already said that both references teach that feature ("**Both** thumbnails and DOM provide users with the ability to link to another document..."). If the stated beneficial result of combining the references is already provided by each reference independently, why would the skilled artisan be motivated to combine the

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references? In other words, there is no motivation to combine references if the result would give you a feature that you already have in either reference alone.

Addressing the second paragraph of the Office's response, this paragraph provides an alternative but similarly erroneous justification for the asserted combination. In summary, this clause says that "since it [(the reduced image format of GroupLab?)] already took into account the structure of a document" then "it would have been obvious ... to combine the two references." Again, this seems to be the "something in common" doctrine at work, i.e., if both references take into account document structure, then the references must be automatically combinable. It bears repeating that this is *not* the law, and as a standard it does not even begin to comport with the requirements set forth in the MPEP regarding when references are properly combinable.

### Summary

The law regarding §103 rejections is not overly complex, but nonetheless there are certain requirements that must be adhered to for such a rejection to be proper. Prime among these is the requirement that any combination of references must be supported by a demonstrated suggestion or motivation in the art. The fact that the motivation may stem from the knowledge available to one of skill does *not* relieve the Office of its duty to actually show what that knowledge is. *See In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (The obviousness inquiry cannot be "resolved on subjective belief using unknown authority.") Rather the, PTO has an obligation and choice to either develop a solid "evidentiary basis" motivating a cited combination, or forego the rejection entirely. *Id.*

Here, the rejections of the claims are made under §103, and yet the requirements have not been met. There is no motivation to combine the references as asserted. When asked for clarification, the Office responded that the references are combinable because they have some

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mutual feature, something in common. Applicants assert that this is clearly not the test for combinability. Moreover, the assertion that one of skill would be motivated to combine the references is belied in the same breath by the further assertion that the resultant combination yields a benefit that was already found in the references *prior* to combination.

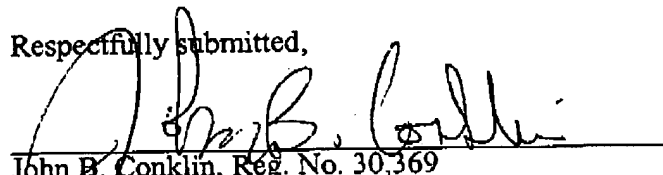
Accordingly, it is respectfully submitted that no proper combination of references teaches the elements of the pending claims, and it is requested that the claims be favorably reconsidered.

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Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If a further telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

Respectfully submitted,



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